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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/751,113	12/29/2000	Tomoko Terakado	208366US6 CONT	6754
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7590 06/19/2002

Oblon, Spivak, McClelland, Maier & Neustadt, P. C.
Fourth Floor
1755 Jefferson Davis Highway
Arlington, VA 22202

EXAMINER

SAJOUS, WESNER

ART UNIT

PAPER NUMBER

2672

DATE MAILED: 06/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/751,113

Applicant(s)

TERAKADO ET AL.

Examiner

Wesner Sajous

Art Unit

2672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-108 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 33-108 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claim 47 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 47 recites the limitation "selectively deleting the additional information stored in said memory" in line 11. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

- I. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

II. Claims 33-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. (5801787), hereinafter Schein.

Considering **claim 33**, Schein, fig. 1, discloses a control device (22) which controls, by transmitting signal, an electric apparatus (14/12) that receives information transmitted via a transmission medium (24), and comprises receives transmitting unit (infrared transmission) for transmitting the control signal to the electric apparatus; a receiver for receiving additional information that has been extracted from the received information... apparatus (as performed between devices 14/12 and 22); an output unit (22/12) for outputting the additional information... display device; a memory (28) for storing at least a portion of said additional information; wherein the electric apparatus includes an extraction unit (integrated in devices 14/12) and transmitting unit (30/31 or the infrared transmission reception section included in the television) for transmitting the additional information received by the receiver to a display device (12). Schein lacks implicit recitation for the claimed erasing unit for deleting at least portion of said additional information.

However, Schein, at col. 5, lines 27-37, describes that the coordinator 14, when using multiple sources for receiving television channels, and have overlapped channels, has the ability to delete and activate the channels displayed on the grid guide. He later describes that the coordinator 14, includes a software memory 28 to store information (fig. 1), and is able to search and retrieve the stored information.

Based on the above embodiment, the ordinary skill in the art at the time of the invention was made would have been motivated to consider modifying Schein, wherein

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an erasing unit for deleting at least portion of said additional information is provided, for the purpose of providing additional functionality to the systems, making it easier for the user to select a show. Such modification would enhance the system's performance, and would be expedient to the artisan skilled in the art.

As an alternate rejection, the invention of claim 33 can be broadly interpreted as performing the function of a remote controller. It must be noted that any conventional remote controller is well known in the art to comprise a computer program or a chip to allow the controller to transmit, receive, store, program, delete, and output information data related to television programming. Accordingly, device 22 in Schein could have provided to perform the broadly aforementioned steps recited in claim 47.

In **claim 34**, the claimed "additional information is an EPG... by the electric apparatus" is met by col. 5, lines 1-5.

Re **claim 35**, the claimed "additional information is advertisement information... by the electric apparatus" is met by col. 5, lines 35-38.

In **claim 36**, the claimed "advertisement information includes coupon information" would have been obvious over Schein col. 5, lines 31-37, since the advertisement could have been in the form of pop-up ads or overlay, and may include coupon information.

In **claim 37**, the claimed "advertisement information includes URL information" would have been obvious over Schein col. 5, lines 31-37, since the advertisement information could be provided from the Internet through a web site address.

As per **claim 38**, the claimed "selecting unit for selecting information...wherein the memory is configured to store the information selected by the selection unit" is met by fig. 1, item 22 and 28.

As per **claims 39-40**, the underlying features are noted to have functions that can be performed by the prior art, when the remote controller 22 is used to communicate signals to either TV 12 or VCR 13 as a second electric apparatus, with the second storing, transmitting, selecting are functions performed between the remote control and the VCR.

As per **claim 41**, it is noted that since device 14 in Schein operates as PC and can accesses the Internet, such can be connected with a network incorporating a server, as an industry standard. Thus, claim 41 would have been obvious over Schein.

In **claims 42 and 44**, the claimed "notifying unit for notifying a user of reception...transmitted in response to an instruction that was issued from the control device" is met by fig. 1, item 12, by means of coordinator 14.

Re **claim 43**, the claimed "control device instructs the electric apparatus to transmit the additional information" is characterized by fig. 1, items 22/14.

As per **claims 45 and 46**, the claimed "output means outputs that part of the additional information which relates to a current channel reception of the electric apparatus ... from a present time onward" is obviously met by the functions performed by devices 12/14 of fig. 1.

Considering **claim 47**, Schein, fig. 1, discloses a transmission medium (incorporated in device 22) for transmitting a computer program that is used in a control

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device (22) which controls, by transmitting signal, an electric apparatus (14/12) that receives information transmitted via a transmission medium (24), and comprising the steps of transmitting (through the infrared transmission signal supplied by the remote controller 22) for transmitting the control signal to the electric apparatus; receiving additional information that has been extracted from the received information...apparatus (i.e., by TV receiver 12); and outputting (e.g. display of TV 12) the additional information... display device; storing (28) at least a portion of the additional information; wherein the computer program further includes the step of extracting (by means of devices 14/12) the additional information and transmitting the additional information extracted at the extracting step for reception at the receiving step (12). Schein lacks implicit recitation for the step of selectively deleting the additional information stored in the memory.

However, Schein, at col. 5, lines 27-37, describes that the coordinator 14, when using multiple sources for receiving television channels, and have overlapped channels, has the ability to delete and activate the channels displayed on the grid guide. He later describes that the coordinator 14, includes a software memory 28 to store information (fig. 1), and is able to search and retrieve the stored information.

Based on the above embodiment, the ordinary skill in the art at the time of the invention was made would have been motivated to consider modifying Schein, wherein an erasing unit for deleting at least portion of said additional information is provided, for the purpose of providing additional functionality to the systems, making it easier for the

user to select a show. Such modification would enhance the system's performance, and would be expedient to the artisan skilled in the art.

Alternatively, the invention of claim 47 can be broadly interpreted as performing the function of a remote controller. It must be noted that any conventional remote controller is well known in the art to comprise a computer program or a chip to allow the controller to transmit, receive, store, program, delete, and output information data related to television programming. Accordingly, device 22 in Schein could have provided to perform the broadly aforementioned steps recited in claim 47.

The invention of **claim 48** recites features substantially the same or equivalent in functions to method **claim 47**, and rejected for the same reasons and rationale set forth for claim 47 above.

The invention of **claim 49**, although slightly different, it recites the underlying steps of the features of claim 33. As the various features of claim 33 have been shown to be obvious over the Schein's disclosure it is readily apparent that the apparatus disclosed by the prior art performs the recited underlying functions. As such, claim 53 are rejected for the same reasons and rationale as claim 33, and incorporated herein. It must be understood that the first and second receiving steps performed by the remote controller when communicating signals to the electrical apparatus (e.g., the television or the VCR) upon interaction by a user.

Re **claims 50-52**, the claimed "electric apparatus is a personal computer; a television receiver, a recording apparatus" is obviously met by devices 14/20, 12, 13.

The invention of **claim 53**, although slightly different, it recites the underlying steps of the features of claim 49. As such, claim 53 are rejected for the same reasons and rationale as claim 49, and incorporated herein.

The invention of **claim 54**, although slightly different, it recites performing functions equivalent to claim 53 and is similarly rejected.

The invention of **claim 55**, although slightly different, it recites performing functions equivalent to claim 48 and is similarly rejected.

III. Claims 56-108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein in view of Kishtaka (6084643).

Considering **claims 56-69**, Schein sets forth or render obvious most claimed features of the invention as recited herein in the above claims 33-46 rejections, but he fails to specifically disclose the claimed --detachable storing means (IC card) for storing the information selected by the selecting means. --

However, the idea of using a detachable memory means, (IC card), for storing the information selected by the selecting means or selection by a user using a remote control device, is a well known teaching in the art as evidence by kishtaka, item 33, fig. 2. Therefore, it would have been obvious to one of ordinary skilled in the art at the time the invention was made to consider incorporate the features of Schein with Kishtaka, wherein a detachable storing means (IC card) for storing the information selected by the selecting means is provided, for the purpose of storing a key necessary for processing a deciphering program.

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The invention of **claims 70-108**, although slightly different, it recites the underlying steps of the features of claims 56-69, respectively. As the various features of claims 56-69 have been shown to be obvious in view of the collective teachings of the Schein's and the Kishtaka's disclosures, they are readily apparent that the apparatus disclosed by the prior art performs the recited underlying functions. As such, the limitations recited in claims 70-108 are rejected for the same reasons and rationale given above for claims 56-69, and incorporated herein.

Conclusion

The prior art considered pertinent to the Applicants' disclosure are as recited in the PTO-892 form.

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Hand-delivered responses should be brought to Crystal
Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor
(Receptionist).

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Wesner Sajous whose telephone number is (703) 308-
5857. The examiner can also be reached on Mondays thru Thursdays and on alternate
Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Michael Razavi, can be reached at (703) 305-4713. The fax phone number
for this group is (703) 308-6606.

Wesner Sajous - WOS

Patent Examiner, art unit 2672



MATTHEW LUU
PRIMARY EXAMINER

June 13, 2002